

REMARKS

* Enclosed is an Appointment of Associate Power of Attorney executed by the Assistant Secretary of Mallinckrodt Baker B.V. authorizing the undersigned and other named attorneys to act on behalf of the assignee of the present application.

* In response to the Office action dated June 29, 2004, enclosed is a substitute specification (pages 1-11) in compliance with 37 CFR 1.52(a) and 1.125. A marked-up copy showing the changes is also enclosed herewith. The substitute specification contains no new matter.

Claims 1-8 have been canceled. Applicants respectfully request entry of the claim amendments noted above. The cancellation of claims 1-8 is not an assent by the Applicant that the claims were anticipated by, or obvious in view of, the references cited by the Office. The Applicant reserves the right to re-file original claims 1-8 in the future during the pendency of the present application or any continuation, continuation-in-part, divisional, reissue or reexamination applications thereof.

Claims 9-19 have been newly added. Claims 9-19 are currently pending.

I. **Substitute Specification**

A substitute specification is being filed herewith in response to the objections of the Examiner regarding the format of the originally filed application.

The paragraphs of the original application have been reorganized under headings suggested by the Examiner. Additionally, corrections of typographical errors present in the original application have been made in the substitute specification.

Support for the inserted text identified in the marked-up version of the substitute application are as follows:

Substitute Specification Inserted Text	Location of Support in Original Specification
Paragraph 0001	Application Data Sheet
Paragraph 0002	Page 1, lines 3-4
Paragraph 0003	Page 1, lines 11-15

Substitute Specification Inserted Text	Location of Support in Original Specification
Paragraph 0004	Page 1, lines 16-20
Paragraph 0005	Page 3, lines 3-11; Page 2, lines 19-21
Paragraph 0006	Page 3, lines 12-15
Paragraph 0007	Page 1, lines 10-11
Paragraph 0008	Page 2, lines 22-23
Paragraph 0009	Page 7, lines 10-11
Paragraph 0010	Page 7, line 12
Paragraph 0011	Page 1, lines 5-9
Paragraph 0012	Page 1, lines 21-25
Paragraph 0013	Page 1, lines 26-34
Paragraph 0014	Page 2, lines 1-9
Paragraph 0015	Page 2, lines 10-11
Paragraph 0016	Page 2, Table 1; Page 2, lines 19-21
Paragraph 0017	Page 2, lines 16-21
Paragraph 0018	Page 2, line 22 to page 3, line 2
Paragraph 0019	Page 3, lines 16-17
Paragraph 0020	Page 3, lines 18-23
Paragraph 0021	Page 3, lines 24-27
Paragraph 0022	Page 3, line 28 to page 4, line2
Paragraph 0023	Page 4, lines 3-8
Paragraph 0024	Page 4, lines 9-17
Paragraph 0025	Page 4, lines 18-21
Paragraph 0026	Page 4, lines 22-25
Paragraph 0027	Page 4, line 26 to page 5, line1
Paragraph 0028	Page 5, lines 2-5; Page 2, lines 19-21
Paragraph 0029	page 5, lines 6-7

Substitute Specification Inserted Text	Location of Support in Original Specification
Paragraph 0030	Page 5, lines 8-13
Paragraph 0031	Page 5, line 14-17
Paragraph 0032	Page 5, lines 18-23
Paragraph 0033	Page 5, lines 24-26
Paragraph 0034	Page 5, lines 27-29; Page 2, lines 19-21
Paragraph 0035	Page 5, line 30 to page 6, line 14; Page 2, lines 19-21
Paragraph 0036	Page 6, lines 15-18
Paragraph 0037	Page 6, lines 19-22
Paragraph 0038	Page 6, lines 23-27
Paragraph 0039	Page 6, lines 28-29
Paragraph 0040	Page 6, line 30
Paragraph 0041	Page 7, lines 2-3; Page 2, lines 19-21
Paragraph 0042	Page 7, lines 4-9

The term "UltraClear" throughout the specification has been replaced with the term "ULTRACLEAR®" to designate the term as a trademark. Furthermore, generic terminology has been included throughout the specification identifying that ULTRACLEAR® is mixture of nonanes, decanes, undecanes and dodecanes as identified at page 2, lines 19-21 of the original specification.

II. Claim Objections

Claims 1, 4, 5, and 7 have been canceled. New claims 9 to 19 do not contain the objected use of quotation marks and hyphens as noted by the Examiner. The term "apolair" has been corrected to "apolar" in the substitute specification and new claims.

III. 35 U.S.C. 112

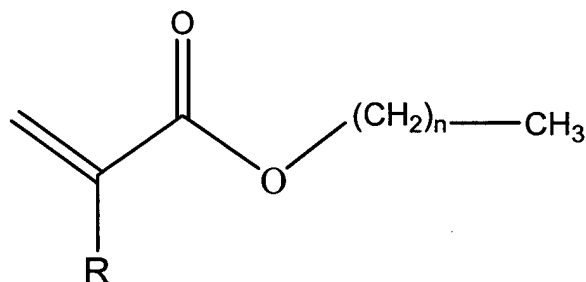
Claims 4, 5, 6, and 8 have been canceled and the phrases "in particular," "such as," "e.g.," and "similar" do not appear in any pending claim.

IV Novelty of Claims 1, 2, 4, 5, 6, 7, and 8

Reconsideration is requested of the rejection of claims 1, 2, 4, 5, 6, 7, and 8 under 35 U.S.C. 102 (b) as being anticipated by Hyde (U.S. 4,341,673) and under 35 U.S.C. 102(e) as being anticipated by Govek et al. (U.S. 6,589,650).

Claims 1, 2, 4, 5, 6, 7, and 8 have been canceled and replaced with new claims 9 to 19.

Claim 9 is directed to a mounting medium solution. The solution comprises one or more saturated hydrocarbon solvents selected from the group consisting of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, and mixtures thereof, and at least one acrylate or methacrylate resin is derived from one or more monomers having the formula:



wherein R is hydrogen or a methyl group and n has a value of 0-19. The saturated hydrocarbon solvent(s) comprise 40% to 90% of the weight of the mounting medium solution and the resin(s) comprise 10% to 60% of the weight of the mounting medium solution. Furthermore, -(CH₂)_n- may optionally be substituted with one or more alkyl substituents when n is at least 1, provided, however, the total number of carbon atoms in the -(CH₂)_n-CH₃ moiety is 1 to 20.

Claim 19 is a mounting medium solution for use in the preparation of slides, said medium comprising one or more saturated hydrocarbon solvents selected from the group consisting of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, and mixtures thereof, and at least one acrylate or methacrylate resin selected from the group consisting of benzyl acrylate and benzyl methacrylate. The saturated hydrocarbon solvent(s) comprise 40% to 90% of the weight of the mounting

medium solution and the resin(s) comprise 10% to 60% of the weight of the mounting medium solution.

Hyde, U.S. Patent No. 4,341,673, discloses a methacrylate polymer concrete mix which comprises an Aggregate Mixture and a Liquid Mixture. The Aggregate Mixture comprises, *inter alia*, a polymerization initiator and 60% to 90% by weight of inorganic fillers such as a blend of silica particles, amorphous silica, calcium carbonate, or alumina trihydrate. See col. 2, lines 37 to 65 and col. 3, lines 9 to 19. The Liquid Mixture comprises "mostly a methacrylate monomer, e.g., 75% or more by weight of the mixture" and a polymerization promoter. See col. 2, line 52 to col. 3, line 9. The Aggregate and Liquid Mixtures are combined and the mixture polymerizes to form a concrete patch. See col. 5, lines 21 to 35. To control shrinkage of the patch, the Liquid Mixture must also contain 5 to 12% of a paraffinic oil and 4 to 10% of an acrylic polymer. See col. 4, lines 25 to 30.

A combination of the Aggregate Mixture and the Liquid Mixture of the Hyde methacrylate polymer concrete mix does not contain 40% to 90% by weight of saturated hydrocarbon solvents selected from the group consisting of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, and mixtures thereof based on the total weight of the concrete mix. Thus, the Hyde methacrylate polymer concrete mix does not anticipate independent claims 9 or 19 or the claims that depend therefrom.

The Liquid Mixture portion of the concrete mix also does not contain 40% to 90% by weight of the saturated hydrocarbon solvents selected from the group consisting of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, and mixtures thereof based on the total weight of the Liquid Mixture. Thus, the Liquid Mixture does not anticipate claims 9 or 19 or the claims that depend therefrom.

Hyde also discloses a two-part, curable, clear methacrylate primer in Example 8 that is applied to a cement surface prior to being overlayed by the concrete mix. The primer contains 85.7% methyl methacrylate by weight. The clear methacrylate primer does not contain 40% to 90% by weight of the saturated hydrocarbon solvents selected from the group consisting of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, and mixtures thereof based on the total weight of the Liquid Mixture. Thus, the primer does not anticipate claims 9 or 19 or the claims that depend therefrom.

Govek et al., U.S. 6,589,650, disclose polymeric cover slip materials. The cover slip materials contain polymers that are dried or cured to form a bonding layer on a film backing. An activating solvent is applied to the bonding layer which dissolves a portion of the layer resulting in the cover slide adhering to the specimen. See col. 4, lines 14-16. Govek et al. disclose that polymers of alkyl acrylate and alkyl methacrylates are suitable polymers for use as the bonding layer. See col. 4, lines 30 to 37.

The mounting medium specified in claim 9 is not anticipated by Govek et al. as a mounting medium solution comprised of 40% to 90% by weight of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, or mixtures thereof, and 10% to 60% by weight of acrylate or methacrylate resin based on the total weight of the solution is not disclosed. Thus, Govek et al. do not anticipate claims 9 or 19 or the claims that depend therefrom.

V. Non-Obviousness of Claims 1 to 8

Reconsideration is requested of the rejection of claims 1 to 8 under 35 U.S.C. 103(a) as being unpatentable over Govek et al. in view of Groat. Claims 9 to 19 replace claims 1 to 8. For a *prima facie* case of obvious to be established, cited references must describe all the elements of the applicant's invention and suggest or provide a motivation to modify or combine the cited references in a manner that teaches or suggests all of the claim requirements. Furthermore, a reasonable expectation of success in the combination must be found in the prior art. MPEP §§ 2143-2143.03.

Groat discloses a mounting media solution for microscopy that consists of approximately 45% by weight of isobutyl methacrylate and styrene copolymers in toluene. Groat's preference for toluene over other solvents is "on account of its general inertness toward stains, and its favorable vapor pressure at the ordinary drying temperatures. Strain (1940) showed that the viscosity of methyl methacrylate polymer solutions in toluene is considerably reduced by replacement of a portion of the toluene by certain other liquids, notably methyl alcohol and 95% ethyl alcohol which are themselves non-solvent; but this does not hold for the copolymer of isobutyl methacrylate and styrene described here." See page 92, last paragraph. In fact, Groat's preference for toluene over other solvents is so great that no other solvent is even mentioned.

Govek et al. disclose cover slip materials that comprise a cover slip, a backing material, a bonding layer comprising alkyl acrylate and alkyl methacrylate polymers, and a solvent to solvate and adhere the bonding layer to a slide. Govek et al. use an activating solvent selected from xylene, toluene, d-limonene, esters of coconut oil, aliphatic hydrocarbon blends, and petroleum distillates to at least partially solvate (*i.e.*, dissolve) and thereby render the bonding layer tacky and adhering the cover slip to the specimen and the microscope slide. See col. 4, lines 10-35 and col. 5, lines 17-20. Significantly, Govek et al. do not disclose forming a medium comprising 40% to 90% by weight of a solvent of any type and 10% to 60% by weight of acrylate or methacrylate resin(s) for any purpose.

When considered in combination, Groat and Govek et al. do not suggest the claimed invention. Of the two, only Groat discloses mounting solutions and Groat expressly and unequivocally prefers comprising toluene as the solvent; in fact, Groat's preference is so great he does not even identify an alternative solvent. Govek et al. identify aliphatic hydrocarbon solvents as one of several potential solvents, but Govek et al. employ them as *an activating solvent* to *at least partially solvate* a preformed polymerized bonding layer (used to adhere a cover slip to the specimen and the microscope slide). No preference for the aliphatic hydrocarbon solvents is expressed relative to the other identified solvents; if anything, Govek et al.'s Example 20 suggests that aliphatic hydrocarbon blends are inferior to D-limonene and Estisol 220, an ester of coconut oil (See Table 4 in column 12). Furthermore, and in any event, Govek et al. do not form a media comprising 40% to 90% by weight of a solvent of any type and 10% to 60% by weight of acrylate or methacrylate resin(s) for any purpose.

It is well settled that the prior art must be considered as a whole. In this case, the Office has not, and indeed cannot, based upon the cited references, articulate any reason a person of ordinary skill would have been motivated to ignore Groat's express preference for toluene in mounting media to arrive at the mounting media defined by claim 9. Govek et al. are concerned with a different application and, based upon their experimental evidence, it appears that D-limonene and Estisol 200 are superior to Tissue Clear (which Govek et al. believed to be an aliphatic hydrocarbon blend) for *their* application. If a person of ordinary skill were to select one of Govek et al.'s solvents for another application, therefore, the first logical choice would be D-limonene or an ester of coconut oil and not aliphatic hydrocarbon blends.

Finally, neither Groat nor Govek et al. specifically nominate C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, or mixtures thereof as solvents for any purpose.

As such, the Office has not established a *prima facie* case of obviousness under 35 U.S.C. 103(a). Therefore, the applicants submit that claims 9-19 are non-obvious and patentable over the cited art relied on by the Examiner.

VI. Claim 8

Reconsideration is requested of the rejection of claim 8 as being anticipated by Govek et al. under 35 U.S.C. 102(e) and alternatively obvious under 35 U.S.C. 103(a). Claims 1 to 8 have been canceled and replaced with new claims 9 to 19.

Govek et al., discussed above, do not disclose a mounting medium solution comprised of 40% to 90% by weight of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, or mixtures thereof, and 10% to 60% by weight of acrylate or methacrylate resin based on the total weight of the solution. Thus, Govek et al. do not anticipate claims 9 to 19 under 35 U.S.C. 102(e).

The Office has asserted that the materials disclosed by Govek et al. possess the same physical properties as those claimed in canceled dependent claim 8, which, *inter alia*, specifies a viscosity range of the mounting medium solution. As discussed above, Govek et al. do not disclose a mounting media solution comprising 40% to 90% by weight of C₅-C₂₀ paraffins, C₅-C₂₀ isoparaffins, or mixtures thereof and 10% to 60% by weight of acrylate or methacrylate resin(s). While the Office has made an unsupported assertion that the materials disclosed by Govek et al. possess the same viscosity properties as those claimed in the present application, it has failed to identify where the cited reference suggests a combination of resin(s) and solvent(s) of the types and percentages specified in claims 9 and 19 and the claims that depend therefrom to achieve the claimed viscosity range. Therefore, the Office has failed to meet its burden of establishing a *prima facie* case of obviousness. As such, the applicant submits that claims 9 and 19 and the claims that depend therefrom are non-obvious in light of Govek et al.

In view of the foregoing, favorable reconsideration and allowance of all claims is requested.

* A check for \$110.00 is enclosed to cover the fee for a one-month extension of time up to and including today's date. Any other charges or overpayment should be applied to deposit account 19-1345.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Anthony R. Kinney". The signature is fluid and cursive, with the first name "Anthony" written in a larger, more prominent script than the last name "Kinney".

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*Enclosure

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